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10/561,416

05/26/2006

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EXAMINER

KIM, STEVEN S

ART UNIT

PAPER NUMBER

3685

NOTIFICATION DATE

DELIVERY MODE

08/14/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/561,416 | Applicant(s) YOSHIKAWA, MASA AKI | |
| | Examiner STEVEN KIM | Art Unit 3685 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☒ Claim(s) 3-4 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/24/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to the Applicant's communication on May 26, 2006. Claims 1-17 have been examined. Claims 1-17 are pending.

Specification

2. It is noted that this application appears to claim subject matter disclosed in prior Application No. PCT/JP04/09052, 2003-174785 (JP), and 2004-177584 (JP) filed May 26, 2006, June 19, 2003 and June 15, 2004 respectively. A reference to the prior application must be inserted as the first sentence(s) of the specification of this application or in an application data sheet (37 CFR 1.76), if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e), 120, 121, or 365(c). See 37 CFR 1.78(a). For benefit claims under 35 U.S.C. 120, 121, or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of all nonprovisional applications. If the application is a utility or plant application filed under 35 U.S.C. 111 (a) on or after November 29, 2000, the specific reference to the prior application must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371 (b) or (f) or

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sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

3. If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference

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in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

Information Disclosure Statement

4. The information disclosure statement filed 3/24/2005 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. Additionally, copies of JP2003-518842 and JP2003-512785 have not been submitted. Moreover, the document numbers of the US Patent Documentation appear to be incorrect (note the format of cited US Patent Application Number). It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Claim Objection

5. As per claims 3 and 4, the claims recite “the expiration date”. It is unclear whether this is referring to “a viewing expiration date”. The Applicant is advised to use the consistent terms throughout the claims.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 16 and 17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

8. Per claim 16, the claim is directed towards a “viewing control program” which represents software per se. Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760.

9. Per claim 17, the claim is directed towards a secure module which read with broadest interpretation to be a program listing, in other words software. Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

12. Per claim 1, the scope of the claim is unclear since the claim is directed to an apparatus while the body of the claim recites method steps/intended use.

13. Furthermore the claim recites "updates ... **the viewing condition information** stored in said processing module through an updating section based on **the viewing condition update information**". The claimed subject matter is ambiguous since the relationship of the viewing condition information and the viewing condition update information is unclear.

14. Claims 2-15 are rejected similarly since they depend on claim 1.

15. Claims 16 and 17 recite similar features as described above. Hence, the claims are rejected similarly as described above.

16. As per claim 4, the claim is directed toward absolute time. However, claim 3 which claim 4 depends recites absolute time as optional.

17. As per claim 5, the claim recites "at which the expiration date is past". The claim, however, mentions multiple expiration dates. Hence, the claim is unclear.

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,892,900 ("Ginter") in view of US Patent No. 6,216,112 ("Fuller").

20. Per claims 1-5, 15, 16, and 17, Ginter discloses a viewing control apparatus (see col. 33, line 66 – col. 34, line 34; col. 62, line 31 – col. 80, line 5) that stores contents identification information and viewing condition information indicating a viewing expiration date of the contents in a processing module and controls reproduction of the contents based on the viewing condition information (see Fig. 5A; Fig. 5B; Fig. 8, secondary storage 652; col. 135, lines 51-58; col. 150, lines 4 – col. 155, line 36; col. 155, line 37 – col. 167, line 67).

21. Ginter does not specifically disclose updates, when an advertisement associated with viewing condition update information for updating the viewing condition information is reproduced, the viewing condition information stored in said processing module through an updating section based on the viewing condition update information. However, Ginter discloses storing of dynamic items, e.g. updating, of secure items used in controlling the use of content, e.g. metering and budgeting including expiration date of the content(see col. 150, line 16 col. 155, line 36). Ginter also teaches various control models, e.g. content usage, including advertising (see col. 18, lines 57-60; col.

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30, line 40 – col. 31, line 5; col. 42, lines 35-66; col. 152, lines 4-16) including tracking mechanism on every advertisement viewed by the user (see col. 312, lines 31 - 32).

Furthermore, Ginter teaches a model where the advertiser pays for the user's usage of the content (see col. 283, lines 52-54). Moreover, Ginter discloses flexible presentation of information, e.g. order of presentation (see col. 320, lines 2-9).

22. Fuller discloses offering of electronic content, e.g. software, graphic, audio, video content, wherein the advertisements are displayed before the content can be used (see Abstract; col. 3, lines 8-15). Hence, in light of the teachings of Ginter and Fuller, it would have been obvious to one of ordinary skill in the art at the time of the invention to include the teaching of Fuller to Ginter as both are related to content distribution. The motivation for combining would be to expose users to advertisement that would have been avoided otherwise with modern technology in viewing content (see Fuller, col. 2, lines 7-38).

23. In further regards to claim 16, Ginter discloses a viewing control program (see col. 63, line 67 – col. 80, line 5; col. 61, line 19 – col. 62, line 30; col. 63, lines 28-34).

24. In further regards to claims 2 and 17, Ginter discloses wherein the processing module is a secure module (see col. 284, lines 50-52; col. 286, lines 24-28; col. 315, lines 45-50, secure subsystems).

25. Moreover, regarding independent claims 1, 16, and 17, the recited "when" is a conditional language, a step not necessarily performed, and hence do not move to distinguish the claimed invention from the cited art. See MPEP 2106 II C.

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26. Also, per claims 3-5, the claims are directed toward expiration date which is considered as non-functional descriptive material (NFDM), thus having no patentable weight. For example, on claim 5, Ginter does not disclose wherein the viewing condition update information includes an expiration date of an advertisement and a source of a latest advertisement to be acquired at a time at which the expiration date is past. Ginter, on the other hand, discloses a viewing control apparatus that stores viewing condition information (see col. 33, line 66 – col. 34, line 34; col. 62, line 31 – col. 80, line 5; Fig. 5A; Fig. 5B; Fig. 8, secondary storage 652; col. 135, lines 51-58; col. 150, lines 4 – col. 155, line 36; col. 155, line 37 – col. 167, line 67). Therefore, as the only difference between the claimed viewing control apparatus and the prior art is NFDM (e.g. viewing condition information), the viewing control apparatus of Ginter is sufficient in terms of art. See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01.

27. As per claim 6, Ginter discloses wherein the contents or the advertisement are acquired via broadcasting, communication or a recording medium (see col. 62, lines 36-45; col. 134, lines 54-58; col. 140, line 45; col. 198, lines 50-55).

28. As per claim 7, Ginter teaches wherein the contents or the advertisement are stored in advance (see col. 14, lines 12-19; col. 17, lines 42-51; col. 18, lines 56-60).

29. As per claim 8-12, the Ginter discloses various encryption techniques (see col. 206, line 56 – col. 228, line 25).

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30. As per claim 13, Ginter also teach wherein when the contents are copied, an advertisement which allows the contents to be viewed is copied together (see col. 31, lines 27-63; col. 139, lines 1-15). Also, the claim merely states the intended result.

31. As per claims 14, the claim is directed toward viewing condition information which is considered as NFDM.

32. Additionally, it appears that independent claims 1-15 and 17 are an apparatus claims. In examination of the apparatus claim, the claims must be structurally distinguishable from the prior art. While features of an apparatus claim may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See MPEP 2114. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Apparatus claims cover what a device is, not what a device does. Hewlett-Packard Co. vs. Bausch & Lomb Inc. (Fed. Circ. 1990). Manner of operating the device or elements of the device, i.e. recitation with respect to the manner in which a claimed apparatus is intended to be employed/used, does not differentiate apparatus from the prior art apparatus. Ex parte Masham, 2 USPQ2d 1647 (BPAI, 1987).

33. In further regards to claims 9-13 and 15-17, the recited "when" is a conditional language, a step not necessarily performed, and hence do not move to distinguish the claimed invention from the cited art. See MPEP 2106 II C.

Conclusion

34. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patent No. 5,794,210 discloses advertisement system and method; US Patent No. 5,629,980 disclose system and method for controlling usage of digital objects; US Patent Application No. 2002/0170053 discloses ECM and EMM distribution; US Patent Application No. 2003/0149665 discloses flexible content distribution system and method; US Patent Application No. 2003/0014310 discloses system and method for providing multimedia files combined with advertisements for providing the multimedia content free to the users;

35. Any inquiry concerning this communication or earlier communications from the examiner should be directed to STEVEN KIM whose telephone number is (571)270-5287. The examiner can normally be reached on Monday - Thursday (7:30AM - 5:00PM).

36. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571)272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

37. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. K./

Examiner, Art Unit 3685

/Calvin L Hewitt II/

Supervisory Patent Examiner, Art Unit 3685